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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,066

10/05/2005

Benoit Pugin

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WASHINGTON, DC 20006-1021

EXAMINER

KATAKAM, SUDHAKAR

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

12/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,066	Applicant(s) PUGIN ET AL.	
	Examiner Sudhakar Katakam	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 7-13 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/5/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the application

1. Applicants remarks/arguments, and election of group IV with traverse in reply filed on 22nd Sep 2008 is acknowledged.
2. Applicants also elected a species, compound 29 in the reply. Since the elected species is appears to be allowable, therefore, the search extended for the non-elected groups, viz., I-III and V-VII for the claims 1-5. Hence, the restriction for the groups I-III and V-VII has been withdrawn and the groups I-VII are combined into a single group for the examination purpose.
3. Group VIII is drawn to a process for preparing compounds of formula 1a and 1b, and is rejoined with the groups I-VII, because formula 1a and 1b appear to be allowable.
4. Groups IX-XII are considered as non-elected groups.
5. Claims 1-6 are examined on the merits in this office action.

Response to Restriction

6. The applicants traversal of the restriction is on the basis that the "all groups do have in common the same technical feature, namely the diphosphines". This is not found persuasive because of the following reasons:

The group IX claims are drawn to a compound of formula VII which is structurally different from the formula Ia or Ib, and also there is no common technical feature among the groups. For example in the formula VIII, group X is a halogen, whereas X is a secondary phosphino group in the claims 1-5.

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Groups X, XI and XII claims are also drawn to structurally different compound from the formula 1a and 1b, and therefore, a lack of unity between the groups.

Therefore, the inventions are independent or distinct because prior art anticipating and/or rendering obvious one group would not necessarily anticipate and/or render obvious the other group. Hence, there will be a serious burden on the examiner if restriction is not required because the inventions require a different field of search. Therefore, restriction for examination purposes as indicated is proper.

Claims 7-13 are withdrawn from further consideration as not being drawn to an elected invention.

The requirement is still deemed proper and is therefore made FINAL.

Quayle Action

7. This application is in condition for allowance except for the following formal matters:

Claims 1-6 are allowable subject to cancellation of non-elected claims.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Allowable Subject Matter

8. Claims 1-6 are allowable and applicants need to cancel the non-elected claims 7-13.

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The following is a statement of reasons for the indication of allowable subject matter: the closest prior art (US 5,872,273) fails to disclose or teach applicants compounds represented by the formula Ia or Ib in the independent claim 1.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhakar Katakam whose telephone number is 571-272-9929. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Sudhakar Katakam/
Examiner, Art Unit 1621

/SHAILENDRA - KUMAR/
Primary Examiner, Art Unit 1621